

REMARKS

The Office Action of October 18, 2005, has been considered by the Applicants. No claims have been amended. Claims 1-32 are pending. Reconsideration of the Application is requested.

Claims 1-12, 16, 17, 19-27, and 30-32 were rejected under U.S.C. 103(a) as unpatentable over Fuller in view of Deubzer (6,251,313). Claims 1-14, 16, 17, 19-22, and 28-32 were rejected under U.S.C. 103(a) as unpatentable over Fuller in view of Pinschmidt, Jr. (6,391,992). Because these two rejections are rebutted with the same argument, Applicants traverse these rejections together.

In the previous Amendment of 27 July 2005, Applicants argued that there is no motivation to combine Fuller with either Deubzer or Pinschmidt, Jr. because Fuller does not teach the hydrolysis is performed in the presence of a "basic catalyst". The Examiner has replied that while the borane complex is a type of catalyst, one of ordinary skill in the art would be motivated to add a basic catalyst as taught by the secondary references to increase the yield of the desired product. This response misses the point, which is that the type of catalyst taught is important and relevant to the patentability of the instant claims. To provide motivation to combine, Fuller must teach the use of a basic catalyst and he does not. Fuller describes only the use of a BTHF complex; he never teaches that it is a basic catalyst. As Applicants have previously stated, Fuller never uses the word "basic" in his specification or his claims. Applicants agree that Deubzer and Pinschmidt, Jr. teach the specific basic catalysts recited. However, there is still no motivation to combine them with Fuller unless Fuller teaches the use of a basic catalyst, which he does not.

The type of catalyst that Fuller teaches is important and relevant to the non-obviousness of the claims. For example, borane is a Lewis acid and Applicants could therefore argue that the BTHF complex should be considered an acidic catalyst. Fuller would then teach away from the instant claims because Fuller does not use a basic catalyst. MPEP § 2145(X)(D). The Examiner has not pointed out where Fuller teaches

that the BTHF₂ complex is a basic catalyst and must make this showing in order to make a *prima facie* case of obviousness. MPEP § 2143.

Applicants submit that the Examiner's conclusion of obviousness is based on improper hindsight argument; see MPEP § 2145(X)(A). In particular, the Examiner is using the "knowledge gleaned only from [Applicants'] disclosure" that a basic catalyst is suitable for use in forming poly(vinylbenzyl alcohol). *In re McLaughlin* 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For these reasons, Applicants request withdrawal of the rejections based on Fuller combined with either Deubzer or Pinschmidt, Jr.

Claims 1-14, 16, 17, 19-22, and 28-32 were rejected under U.S.C. 103(a) as unpatentable over Fuller in view of Sato (5,710,211). Applicants traverse the rejections.

In the previous Amendment of 27 July 2005, Applicants argued that Sato taught the use of pyridine as a reaction catalyst between (A) a vinyl ester polymer having an epoxy group and (B) a compound having a thiol or thioester group. See col. 5, lines 4-14. Sato's starting reactants are very different from the reactants of the instant claims and no reason was given by Sato or the Examiner to believe that a catalyst suitable for Sato's reactants would also be suitable as a solvent in the instant claims. The Examiner has replied that Sato is relied upon simply for its teaching of solvents (i.e. pyridine) suitable for use in similar reactions. Sato does not teach the use of pyridine as a solvent; he teaches the use of pyridine as a catalyst between two specific reactants. A solvent and a catalyst perform different functions and the recitation of pyridine as a catalyst would not suggest its use as a solvent to one of ordinary skill in the art. Therefore, the combination of Fuller and Sato would not render obvious the instant claims.

In the rejection, the Examiner has also stated that it would be obvious to use the bases/solvents taught by Sato as the basic catalyst of the instant claims. As argued above, Fuller does not teach the use of a basic catalyst. As such, there is no motivation to combine Fuller with Sato. In addition, Sato teaches the use of pyridine as a catalyst for the reaction of two specific reactants. Neither reactant is similar to poly(vinylbenzyl acetate) and the Examiner has not shown where Fuller or Sato explain how a catalyst

suitable for one reaction is suitable for a different reaction. In particular, note that Sato's reaction occurs along the polymer backbone, not at the alcohol site as in the instant reaction. Compare Sato's polymers I and II in col. 8 with Fig. 1 on page 5 of the instant specification. The combination of Fuller and Sato would not teach or suggest the use of pyridine as a basic catalyst and therefore do not render obvious the instant claims. MPEP § 2143.01.

For these reasons, Applicants request withdrawal of the rejections based on Fuller combined with Sato.

CONCLUSION

For the reasons given above, Applicants submit the pending claims (1, 3-16, and 18-32) are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

It is believed that no fee is due in conjunction with this response. If, however, it is determined that fees are due, authorization is hereby given for deduction of those fees, other than the issue fees, from Deposit Account No. 24-0037.

Respectfully submitted,

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